



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/577,927 05/24/00 WELLE

R 7413-1004

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EXAMINER

HANIG, R

ART UNIT

PAPER NUMBER

2878

DATE MAILED:

11/07/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/577,127

Applicant(s)

Wells

Examiner

Haring

Group Art Unit

2878

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 mo MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 25-39 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 25-39 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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1. Claim 25 is objected to because of the following informalities: the claim does end with a period. Appropriate correction is required.
2. The reissue oath or declaration filed with this application is defective because it fails to describe the actual error(s) in the patent, i.e., it fails to particularly specify the “defects” in the specification or drawing, 37 CFR 1.175(a)(2); and/or it fails to distinctly specify the “excess or insufficiency” in the claims, 37 CFR 1.175(a)(3). The applicant has not stated which part of the claims is insufficient and prevents them from obtaining the scope of the submitted new claims.
3. Claims 25-39 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

4. Claims 25-29 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. V. Stein, Inc.*, 142 F. 3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F. 3d 1464, 45 USPQ2D 1161 (fED. CIR. 1997); *Ball Corp. v. United States*, 729 F. 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the

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meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by filing of the present reissue application. Specifically, applicant can not acquire claims that are broader in an aspect germane to a prior art rejection and narrower in another aspect unrelated to the rejection. The reissue claims' scope are narrower with respect to applicant's patent claims of a taggant method such as the use of a pen or in clothing, but broader with respect to using isotopic taggant or defining the specifics of the isotopic ratios that were argued in the rejection of the initial claims in the parent application.

5. Claims 1-24 allowed.

6. The following is a statement of reasons for the indication of allowable subject matter: The prior art does not show using taggants with artificial isotopic abundance ratio which are unchanged by chemical reaction. Also not shown is using two elements as taggants each having two stable isotopes with artificial isotopic abundance, or a way of correcting for contaminants.

7. The applicant is reminded that when the application is in condition for allowance the original ribboned patent must be submitted or an affidavit explaining its loss or inaccessibility.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. Hanig whose telephone number is (703) 308-4853; or the receptionist (703) 308-0956. Fax No. (703) 308-7722.

RAH
November 6, 2000


SEUNGSOOK HAM
SUPERVISORY PATENT EXAMINER
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